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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sagoma Plastics, Inc.

Serial No. 76544524

James C. Wray and Matthew J. Laskoski for Sagoma Plastics,
Inc.

S. Michael Gaafar, Trademark Examining Attorney, Law Office
116 (M.L. Hershkowitz, Managing Attorney).

Before Seeherman, Hairston and Holtzman, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Sagoma Plastics, Inc. has appealed from the final
refusal of the Trademark Examining Attorney to register THE
CLIP as a trademark for goods which are identified as
"holder mountings in books, book bindings, book binder,
leaf and package connectors, page mounts and books with

rigid pages for holding objects.”¹ The Examining Attorney has refused registration pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the grounds that applicant’s mark is merely descriptive of its identified goods, and, citing TMEP §1402.01, that the identification of goods is indefinite. This section of the Trademark Manual of Examining Procedure in turn cites Sections 1(a)(2) and 1(b)(2) of the Trademark Act, and Trademark Rule 2.32(a)(6).²

The appeal has been fully briefed. Applicant did not request an oral hearing.

Before discussing the issues on appeal, we must first address the question of what the present identification of goods is. The identification of goods has undergone a series of amendments, as detailed in the Examining Attorney’s brief.³ At the time applicant and the Examining

¹ Application Serial No. 76544524, filed September 12, 2003, based on an asserted bona fide intent to use the mark in commerce.

² The final refusal also included the alternative refusal that, if the mark were not merely descriptive of the goods, it was deceptively misdescriptive of them, and also made final a request for information about the goods. Applicant subsequently submitted the required information, and in his brief the Examining Attorney withdrew both this requirement and the refusal based on deceptive misdescriptiveness. Accordingly, these are not issues on appeal.

³ In response to the Examining Attorney’s finding that the original identification was indefinite, applicant filed an amendment with its response of August 25, 2004. When this amendment was found indefinite in the final Office action mailed

Attorney filed their briefs, the operative identification was the one set forth at the beginning of this opinion. Then, as part of its reply brief, on page 2 of its "Remarks" section, applicant proposed another amendment of the identification "in order to clarify the goods." We note that this is not the proper way to have an amendment to the identification considered at that stage of the appeal. Rather, applicant should have filed, by separate paper, a "Request for Remand," which should also have included a showing of good cause for remanding the application. See TBMP §1209.04. However, despite applicant's failure to follow proper procedure, the Board remanded the application to the Examining Attorney to consider the proposed amendment. That remand was for the limited purpose of having the Examining Attorney consider the amendment, and the order stated that if the amendment was not persuasive the Examining Attorney was simply to issue an Office action to that effect, and return the file to the Board. On October 20, 2005, the Examining Attorney issued an action in which he stated that the proposed amendment was unpersuasive.

October 21, 2004, applicant filed, with its request for reconsideration dated March 21, 2005, a further amendment.

Because the Examining Attorney did not accept the proposed amendment, the identification of goods remains as it was in the amendment submitted by applicant on March 21, 2005. As previously noted, this is the amendment that was in effect when the appeal briefs were filed. The amendment proposed in applicant's reply brief has been given no effect, since the Examining Attorney has not had an opportunity to present in his brief his reasons as to why the proposed identification is indefinite, or his reasons as to why the mark is merely descriptive with respect to this identification.⁴

We now turn to the issue of whether applicant's mark is merely descriptive of its goods. A mark is merely descriptive, and therefore prohibited from registration by Section 2(e)(1), if it immediately conveys knowledge of the ingredients, qualities, or characteristics of the goods with which it is used. In re Gyulay, 810 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987). The determination of mere descriptiveness must be made not in the abstract or on the

⁴ We note that in the Examining Attorney's brief, the identification of goods he lists on page 1 is slightly different from the actual identification submitted by applicant in its March 21, 2005 amendment. The Examining Attorney, in discussing the requirement for an acceptable identification at p. 12 of his brief, has set forth the correct identification. Therefore, there is no question that the Examining Attorney treated the March 21, 2005 amendment as the operative one.

basis of guesswork, but in relation to the goods or services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978).

In support of the refusal of registration, the Examining Attorney points to certain dictionary definitions which were made of record, as well as other definitions submitted with his appeal brief, which we judicially notice.⁵ These submissions include the following definition of "clip," taken from The American Heritage Dictionary of the English Language, 4th ed., © 2000, and provided by Bartleby.com:

Clip: n. 1. Any of various devices for gripping or holding things together, a clasp or fastener. 2. A piece of jewelry that fastens with a clasp or clip; a brooch. 3. A cartridge clip.

v. 1. To fasten with or as if with a clip; hold tightly. 2. *Archaic* To embrace or encompass

In addition, the Examining Attorney points to the materials submitted by applicant in response to the

⁵ The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

Examining Attorney's request for product information. In particular, an article from the March 2004 issue of "Injection Molding Magazine" about applicant's company features applicant's "package for optical disks that's designed with the familiar look and feel of a conventional book. Sagoma calls it 'The Clip Binding System' (TCBS)." A caption next to a depiction of the product states that "Sagoma's TCBS combines the attractive look and feel of traditional book binding with durable, high-quality plastic pages." The article describes the product as using

custom-colored disk-holding "pages"
molded from ABS, PC, or HIPS-materials
that are stronger than the crystal PS
used in conventional jewel boxes.
Flexible PP **clips** bind the pages.
(emphasis added)

Although applicant's identification does not make specific reference to packages for optical disks, applicant did submit the material in response to the Examining Attorney's request for information about its goods and therefore we can consider it as indicating the nature of the goods which are the subject of this application. Further, applicant's identification, which includes "books with rigid pages for holding objects," could encompass such packages. In particular, the objects held by the books with rigid pages could be optical disks. In this

connection, we note applicant's statement in its reply brief that its goods "are devices to fasten rigid pages to create a book format storage unit," and that "optical disks are simply one example of storage possibilities." Reply brief, p. 2.

The description of applicant's product in "Injection Molding Magazine" uses the word "clips" to describe the objects binding the pages in applicant's binding system. Whether applicant itself used this term in furnishing the information about its product, or the writer of the article decided to use the term, the use of the term shows that THE CLIP is merely descriptive of a significant feature of applicant's goods, namely, its bindings and books with rigid pages for holding objects use clips to bind the pages. Accordingly, the refusal of registration on the ground that the mark is merely descriptive is affirmed.

In reaching this conclusion we have considered applicant's various arguments. Applicant asserts that THE CLIP does not give an immediate idea of the product to the average purchaser, but that such purchaser "will have to invest imagination and time to figure out what the mark actually represents." Brief, pp. 2-3. However, as applicant itself has recognized, and as we have stated in this opinion, the determination of mere descriptiveness

must not be made in the abstract. Thus, the question is not whether a purchaser can guess from seeing the mark what the goods will be, but whether, upon seeing the mark in connection with the goods, the purchaser will immediately understand the mark as referring to a characteristic of the goods. The evidence from "Injection Molding Magazine," which describes applicant's goods as using "clips," establishes that THE CLIP will immediately convey to purchasers information about a significant characteristic of the goods.

Applicant also points to the fact that "clip" has a variety of meanings, including a piece of jewelry and a cartridge clip. Again, however, the mark must be viewed in relation to the goods. When used in connection with the identified goods, consumers will not ascribe the dictionary meanings of a piece of jewelry or a cartridge clip; rather, they will view THE CLIP as referring to "a device for gripping or holding things together, a clasp or fastener."

Applicant also attempts to distinguish the various cases cited by the Examining Attorney based on their factual situations. However, it is clear that, just as we have done in this opinion, the Examining Attorney cited these cases in support of the trademark principle which he was asserting.

Applicant has posed a series of questions based on tests that determine whether a mark is merely descriptive. For example, applicant asks, "Does the mark directly convey an unequivocal idea" and answers this question, "No. The mark is suggestive." Brief, p. 6. Applicant's unsupported statements, however, do not show that its mark is not merely descriptive, and they have no persuasive value. With respect to the question posed by applicant, "Even though the mark may tell something, is it likely to conjure up some other connotation, e.g., Sugar & Spice, Polly Pitcher?", applicant answers "Yes. THE CLIP is suggestive." Brief, p. 6. However, we disagree that THE CLIP for the identified goods is similar to the situations in *In re Colonial Stores Incorporated*, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (the SUGAR & SPICE case) and *Blisscraft of Hollywood v. United Plastics Company*, 294 F.2d 694, 131 USPQ 55 (2d Cir. 1961)(the POLY PITCHER case). In those cases, the marks had a double entendre, i.e., a meaning totally different from their descriptive meaning which made them not merely descriptive. In this case, on the other hand, as used in connection with the identified goods THE CLIP has only the meaning of the clips that are used in the bindings of the products.

Finally, applicant asserts that "nothing in the record suggests that others in the relevant field have used or would need to use THE CLIP to describe their goods." Brief, p. 6. However, as the Examining Attorney points out, "the fact that an applicant may be the first and sole user of a merely descriptive designation does not justify registration where the evidence shows that the term is merely descriptive of the identified goods," citing *In re Acuson*, 225 USPQ 790 (TTAB 1985) and *In re National Shooting Sports Foundation, Inc.*, 210 USPQ 1018 (TTAB 1983). Brief, p. 9.

The second issue on appeal is the acceptability of applicant's identification of goods: "holder mountings in books, book bindings, book binder, leaf and package connectors, page mounts and books with rigid pages for holding objects." Applicant did not address this basis for refusal in its appeal brief. The Examining Attorney, in his brief, asserts that this identification does not provide the common commercial name for the holder mountings. The Examining Attorney also takes the position that the subject matter of the books is "for holding objects," apparently because in the Office actions applicant was asked to amend the identification for the "books with rigid pages" by indicating the subject matter

of the books. The Examining Attorney contends that applicant's goods, "books with rigid pages for holding objects" should be identified as a type of storage unit and not a type of book. Based on the informational material submitted by applicant, the Examining Attorney asserts that because applicant's goods are used for storage of optical disks, the goods are a type of storage unit and not a book and should be identified as "optical disk packaging in the form of a book with rigid pages" and classified in Class 9, where storage items are placed, rather than in Class 16.

Applicant has responded to this latter point in its reply brief, stating that the goods are not merely optical disk storage devices, but that "the mountings, connectors and binders are capable of holding other rigid pages that in turn hold materials other than optical disks." Reply brief, p. 2. Applicant further states that "the goods are mountings, connectors and binders used to create general purpose storage devices in a book format." Id.

It is clear from the above discussion that the current identification does not indicate the goods with the requisite degree of definiteness. From applicant's comments in its reply brief (and the description in the magazine article), it appears that applicant's goods are a system consisting of mountings, connectors and binders

which are used to create a book-like storage device.

"Holder mountings in books, book bindings, book binder, leaf and package connectors, page mounts and books with rigid pages for holding objects" does not adequately identify this system. Moreover, although applicant's goods are a storage device that has a book format, they would not be considered "books with rigid pages."

Accordingly, we agree with the Examining Attorney that the present identification of goods is indefinite.

Decision: The refusal on the ground that the mark is merely descriptive of the goods and the requirement for an acceptable identification of goods are affirmed.